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09/694,402	10/22/2000	John Thaddeus Pienkos		9105

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EXAMINER
MORGAN, ROBERT W

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Office Action Summary	Application No. 09/694,402	Applicant(s) PIENKOS, JOHN THADDEUS
		Examiner Robert W. Morgan	Art Unit 3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/17/07*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 20-25* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 20-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 8/17/07 has been entered.

Notice to Applicant

2.   In the amendment filed 8/16/07, the following has occurred: claims 1, 13, 14, 21 and 22

have been amended. Claims 1-14 and 20-25 are pending.

Claim Rejections - 35 USC § 112

3.   The rejections under 35 U.S.C. 112, first paragraph have been withdrawn by the

examiner due to the amendment filed on 8/16/07.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1-6, 9, 11, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of

financial potholes," The New York Times, March 23, 1997, pg. 3, 11), Cullen et al. (6,272,528)

and in view of 5,873,066 to Underwood et al.

(A) As per claim 1, Luchs discloses fully computerized insurance premium quote request

and policy issuance method comprising:

(a) entering data into fields relating to a desired insurance coverage, wherein the fields

include the effective date of the insurance policy, the expiration date of the insurance policy, and

the zip code and state of the policy holder (Fig. 10A-B, col. 22 line 5 to col. 23 line 28), wherein

the insurance is related to a dwelling, a homeowner (i.e., a house), an automobile, and watercraft

(Fig. 10B, col. 7-8 see Table, col. 23 lines 3-15);

(b) receiving at the central processor, which includes a databank, the information entered

into fields (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);

(c) electronically and automatically comparing the data in the insurance application to

certain underwriting criteria before actually proceeding with the printing of the insurance

application, wherein the underwriting criteria compared with data include the effective date,

expiration date, and city/ country code (col. 4 lines 26-47, col. 7 line 28 to col. 11 line 2, col. 16

line 30 to col. 17 line 5);

(d) sending the policy to printing if the policy does not need further approval based on the

criteria, and wherein if further approval is needed, the policy is sent to underwriting for approval

(col. 16 lines 30-52).

Luchs includes the feature of receiving a customer specification setting time limits

regarding a desired amount of insurance coverage (i.e., the effective date and the expiration

date). However, Luchs does not include the feature of the time limit specifying a time period of

less than a month. Felton discloses in his article that it is well known in the insurance arts to

provide insurance to customers, wherein the insurance is limited to periods of time of 15 days or

30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the features of Felton within the method of Luchs with the motivation of

allowing a customer to reduce the high cost of insurance (Felton; page 1).

Luchs and Felton do not expressly disclose the terminal being customer operated.

However, Luchs clearly discloses a terminal. See Figure 1 and col. 3 lines 5-15.

Cullen discloses obtaining details of a user's requirements for an insurance quotation via

a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance

quotation at a server, and delivering the insurance quotation information, such as the types of

insurance available and the price of the insurance based on insurer-specific underwriting rules

(reads on "confirmation"), to the user at the user's computer, wherein the user's computer is

operated by a customer wishing to purchase vehicle insurance (col. 1 lines 10-18, col. 2 lines 1-

11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the features of Cullen within the method taught collectively by Luchs and

Felton with the motivation of allowing a customer to receive the most suitable quotation for

insurance over the Internet (Cullen: col. 1 line 60 to col. 2 line 11).

Luchs, Felton and Cullen fail to teach the claimed receiving a further signal from the

customer-operated terminal indicating that the desire insurance is still desired; and

--the claimed concluding an arrangement so that the desired insurance coverage

concerning the time period is provided to the customer.

Underwood et al. teaches a computer-implemented system for managing underwriting, quoting and binding insurance companies, where at step 132, if a quote is accepted by the user a policy is issued and accepted using a graphical user interface (see: column 6, lines 38-45 and Fig. 13).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include the computer-implemented system for managing underwriting, quoting and binding insurance companies as taught by Underwood et al. with the system as taught by Luchs and Felton with the motivation of providing a system for quoting, binding and later issuing an insurance contract in which all relevant information pertaining to the risk is properly documented and permanently stored (see: Underwood et al.: column 1, lines 60-64).

(B) As per claim 2, Luchs discloses:

(a) allowing an operator to enter data into a form related to an insurance policy (col. 3 lines 16-38);

(b) entering data into fields in a form relating to a desired insurance coverage, wherein the fields include the effective data of the insurance policy, the expiration date of the insurance policy, and the zip code and state of the policy holder (Fig. 10A-B, col. 3 lines 17-38, col. 22 line 5 to col. 23 line 28);

(c) receiving at the central processor, which includes a databank, the information entered into fields (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52); electronically and automatically comparing the data in the insurance application to certain underwriting criteria before actually proceeding with the printing of the insurance application,

wherein the underwriting criteria compared with data include the effective data, expiration date,

and city/ country code (col. 7 line 28 to col. 20 line 50);

(d) sending the policy to printing if the policy does not need further approval based on

the criteria, and wherein if further approval is needed, the policy is sent to underwriting for

approval (reads on "providing a preliminary indication that the customer will have an ability to

order insurance) (col. 16 lines 30-52);

(e) assigning a client number to the client and receiving data such as the name of the

policy requestor and the client number of the policy requestor (Fig. 1, 10A-B, col. 2 line 55 to

col. 3 line 5, col. 3 lines 16-39, col. 5 line 61 to col. 6 line 12, col. 7 line 28 to col. 20 line 50,

col. 22 lines 5-35, col. 28 lines 20-52).

As per the recitation of "temporally-limited amounts of insurance" and "geographically-

limited amounts of insurance," note the teachings of Luchs and Felton within claim 1.

(C) As per claim 3, Luchs discloses the fields including the effective date of the

insurance policy, the expiration date of the insurance policy, and the zip code and state of the

policy holder (Fig. 10A-B, col. 22 line 5 to col. 23 line 28).

(D) As per claim 4, Luchs discloses inputting data into a form, wherein the data input is

the name of the policy requestor and the client number of the policy requestor, wherein the

inputted data is received at the processor (Fig. 10A-10B, col. 2 line 55 to col. 3 line 5, col. 3 lines

16-39, col. 21 lines 39-58, col. 22 lines 5-35, col. 28 lines 20-52).

(E) As per claim 6, Luchs discloses the "start time" being the effective date and the

"finish time" being the expiration date (Fig. 10B). It is noted that an effective date is measured

with respect to the expiration date (i.e., prior to the expiration date) and the expiration date is

measured with respect to the effective date (i.e., after the effective date).

(F) As per claim 9, Luchs discloses the insurance coverage relating to a automobile and a

watercraft, such as a boat (col. 7-8 Table continued in col. 9-10).

(G) As per claim 13, Luchs and Felton disclose allowing a user to input geographical

information such as a zip code, state, or city (Fig. 10A-B), wherein the user input is received via

telephone lines (see: Luchs: col. 13 lines 59-63).

Luchs and Felton fail to teach the claimed concluding an arrangement so that the desired

amount of insurance coverage is provided to the customer.

Underwood et al. teaches a computer-implemented system for managing underwriting,

quoting and binding insurance companies, where at step 132, if a quote is accepted by the user a

policy is issued and accepted using a graphical user interface (see: column 6, lines 38-45 and Fig.

13). In addition, Underwood et al. teaches at step 106, entering policy limits such as the effective

and expiration dates (see: column 4, lines 32-35 and 7), this suggest that the policy could be

renewed and the all step repeated.

The obviousness to combining the teachings of Underwood with the system taught by

Luchs and Felton are discussed in rejection of claim 1, and incorporated herein.

(H) As per claim 14, Luchs discloses fully computerized insurance premium quote

request and policy issuance method comprising:

(a) entering data into fields relating to a desired insurance coverage, wherein the fields

include the effective data of the insurance policy, the expiration date of the insurance policy, and

the zip code and state of the policy holder, wherein the insurance coverage pertains to a vehicle

or home owned by a client (reads on "pertaining to an item owned by the customer") (Fig. 5, Fig.

10A-B, Fig. 10D-F, Fig. 11C-E, Table in col. 7-8, col. 20 lines 1-28, col. 22 line 5 to col. 23 line

28);

      (b) receiving at the central processor, which includes a databank, the information entered

into fields (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);

      (c) electronically and automatically comparing the data in the insurance application to

certain underwriting criteria before actually proceeding with the printing of the insurance

application, wherein the underwriting criteria compared with data include the effective date,

expiration date, and city/ country code (col. 4 lines 26-47, col. 7 line 28 to col. 11 line 2, col. 16

line 30 to col. 17 line 5);

      (d) creating a suspense file for quotations which are pending approval by the insured,

thus notifying the underwriter that a quotation was given, wherein the client can modify the

policy at a later time (col. 13 lines 29-42, col. 16 lines 13-51); and

      (e) sending the policy to printing if the policy does not need further approval based on

the criteria, and wherein if further approval is needed, the policy is sent to underwriting for

approval (col. 16 lines 30-52).

      Luchs includes the feature of receiving a customer specification setting time limits

regarding a desired amount of insurance coverage (i.e., the effective date and the expiration

date). Luchs also discloses (e) sending the policy to printing if the policy does not need further

approval based on the criteria, and wherein if further approval is needed, the policy is sent to

underwriting for approval (col. 16 lines 30-52). However, Luchs does not include the feature of

specifying a time period of less than a month and providing notification to the customer-operated

terminal. Felton discloses in his article that it is well known in the insurance arts to provide

rental car insurance to customers, wherein the rental car insurance is limited to periods of time of

15 days or 30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the features of Felton within the method of Luchs with the motivation of

allowing a customer to receive insurance only for the period of time in which they are using the

car (Felton; pg. 2, par. 3).

Cullen discloses obtaining details of a user's requirements for an insurance quotation via

a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance

quotation at a server, and delivering the insurance quotation information, such as the types of

insurance available and the price of the insurance based on insurer-specific underwriting rules

(reads on "notification"), to the user at the user's computer, wherein the user's computer is

operated by a customer wishing to purchase vehicle insurance (col. 1 lines 10-18, col. 2 lines 1-

11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the features of Cullen within the method taught collectively by Luchs and

Felton with the motivation of allowing a customer to receive the most suitable quotation for

insurance over the Internet (Cullen: col. 1 line 60 to col. 2 line 11).

As per the recitation of "during a preliminary period of time" and "during a later period

of time," note Luchs's teachings of creating a suspense file to access insurance quotations which

are pending approval by the insured.

Luchs, Cullen, Felton and Underwood do not *expressly* disclose repeating step (b).

However, it is noted that updating insurance information is well known as described by Luchs

client's that requests supplemental coverage or wants to add further risks to a policy or rider (col.

1 lines 50-62). It is respectfully submitted that repeating steps appears to be a form of

duplication of "parts" (i.e., steps). The courts have broadly held that the duplication of parts is

obvious. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). As such, these changes do

not present a patentable distinction over the applied prior art of record.

6.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al.

(4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes,"

The New York Times, March 23, 1997, pg. 3, 11) in view of 5,873,066 to Underwood et al. as

applied to Claim 1 above, respectively, and in further view of Cullen et al. (6,272,528).

As per claim 5, the teachings of Luchs and Felton, and the motivation for their

combination is discussed above in the rejection of claim 1, and incorporated herein.

Luchs teaches inputting effective and expiration dates and the client's name via a

terminal (col. 7 line 28 to col. 8 line 30, Table in col. 7-8, col. 28 lines 20-51).

Luchs fails to teach coupling the client and server computer via the internet. Cullen discloses the

client and server computers being connected via the Internet (col. 3 lines 1-10). In addition,

Cullen discloses a computer operated by a customer for obtaining information about vehicle

insurance policies (Fig. 1, col. 1 lines 10-19, col. 2 lines 1-11, col. 3 lines 1-21, col. 7 line 15-

55). At the time the invention was made, it would have been obvious to one of ordinary skill in

the art to include the teachings of Cullen within the method taught collectively by Luchs and

Felton with the motivation of allowing remotely located clients to access information (Cullen; col. 3 lines 1-10).

7.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) and Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11) in view of 5,873,066 to Underwood et al. as applied to Claim 1 above, respectively, and in further view of Mizuno (6,380,953).

(A) As per claim 7, the teachings of Luchs and Felton, and the motivation for their combination is discussed above in the rejection of claim 1, and incorporated herein.

Luchs teaches receiving an inquiry from a customer (col. 3 lines 16-38). Luchs teaches the timer period indication is an indication of a particular discrete time slot (see Fig. 10B, effective and expiration date). Luchs and Felton fail to teach a single indication of a particular discrete time unit including one of a Sunday, a predefined evening time slot, and a noon-hour time slot.

These features are well-known in the art as evidenced by Mizuno which teaches a means for defining a time period in terms of a start and/or finish time and also a means for selecting a day (Sunday) as a time period (Figures 3-7; col. 2 lines 1-60. Col. 3, Ln. 28-41, Col. 5, Ln. 43-50, col. 8 lines 5-28).

At the time of the invention, one of ordinary skill in the art would have been motivated to add a means of defining a time period with respect to the start and/or a finish time and a means of selecting a single day as a time period in order provide a display with improved scroll operability upon displaying information as recited in Mizuno (Mizuno; Col. 1, Ln. 64-67).

8.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al.

(4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes,"

The New York Times, March 23, 1997, pg. 3, 11) in view of 5,873,066 to Underwood et al. as

applied to claim 1, and further in view of Pescitelli et al. (5,845,256).

        (A) As per claim 8, the teachings of Luchs and Felton, and the motivation for their

combination is discussed above in the rejection of claim 1, and incorporated herein.

        Luchs fails to expressly disclose receiving credit card information from a customer.

        Pescitelli discloses payment for a policy being made by credit card, wherein the credit car

is inserted into a credit card reader and is authorized (col. 2 lines 4-13).

        At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the aforementioned features of Pescitelli within the method taught

collectively by Luchs and Felton with the motivation of allowing a customer to pay for insurance

immediately (Pescitelli; col. 2 lines 4-13).

9.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al.

(4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes,"

The New York Times, March 23, 1997, pg. 3, 11) in view of 5,873,066 to Underwood et al. as

applied to claim 1, and further in view of Official Notice.

        (A) As per claim 10, Luchs discloses the insurance coverage relating to a automobile and

a watercraft, such as a boat (col. 7-8 Table continued in col. 9-10). Luchs and Felton does not

explicitly disclose insuring a luxury automobile. However, the Examiner respectfully submits

that it is well known in the art of insurance to insure luxury automobiles as well as other types of

automobiles. The motivation for modifying Luchs and Felton being to provide insurance

coverage for different types of vehicles.

10.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al.

(4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes,"

The New York Times, March 23, 1997, pg. 3, 11) in view of 5,873,066 to Underwood et al. as

applied to claim 1, and further in view of Quicken (Quicken website, Accessed from

www.archive.org, dated 12/12/1998).

        (E) As per claim 11, Luchs discloses a central processor of an insurance company (col. 3

lines 17-55), and providing the field and a confirmation as discussed in the rejection of claim 1

above. However, Luchs and Felton fail to expressly disclose the field and communication being

provided "onto an internet communications link for receipt by a web client terminal that is the

customer-operated terminal." Cullen discloses using the Internet to provide communications

between a server and a customer computer (Fig. 1, col. 3 lines 1-21). At the time the invention

was made, it would have been obvious to one of ordinary skill in the art to include the features of

Cullen within the method taught collectively by Luchs and Felton with the motivation of

allowing customers to access information from many different sources over the Internet (Cullen;

col. 1 lines 10-28).

11.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al.

(4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes,"

The New York Times, March 23, 1997, pg. 3, 11) in view of 5,873,066 to Underwood et al. as

applied to claim 1, and further in view of Serdy (5,990,886).

(A) As per claim 12, the teachings of Luchs and Felton, and the motivation for their combination is discussed above in the rejection of claim 1, and incorporated herein.

Luchs and Felton fail to teach wherein the input of the geographical region indication occurs by at least one of providing at least one map and receiving a demarcation indication which indicates a specific region on the map; and receiving at least one selection of a geographical region from a list of possible geographical regions. It is respectfully submitted that claim 12 only requires one of the aforementioned limitations.

Serdy teaches the input of the geographical region indication occurring by at least one of providing at least one map and receiving a demarcation indication which indicates a specific region on the map is well known in art. See Fig. 4-6 and col. 1 lines 25-64. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Serdy within the method taught collectively by Luchs and Felton with the motivation of enabling a user to quickly input a geographic region without having to type the name of the geographic region (Serdy, col. 1 lines 27-37).

12.   Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), and Cullen et al. (6,272,528), as applied to claim 14, and further in view of Insuremarket (note, previously referred to as Quicken) (Quicken website, Accessed from www.archive.org, dated 12/12/1998).

(B) As per claim 20, the teachings of Luchs, Felton, Cullen and the motivation for their combination are incorporated herein.

Luchs discloses a central processor of an insurance company (col. 3 lines 17-55).

Luchs and Felton do not expressly disclose providing web page information onto the internet for receipt by a client computer that is the customer-operated terminal, wherein the notification is provided onto the internet for receipt by the customer-operated terminal, and wherein the customer information is received off of the internet after being transmitted by the customer-operated terminal.

Cullen discloses obtaining details of a user's requirements for an insurance quotation via a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance quotation at a server, and delivering the insurance quotation information, such as the types of insurance available and the price of the insurance based on insurer-specific underwriting rules (reads on "notification"), to the user at the user's computer, wherein the user's computer is operated by a customer wishing to purchase vehicle insurance, wherein information is provided to and from the customer's computer and the servers via the Internet (Fig. 1, col. 1 lines 10-18, col. 2 lines 1-11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Cullen within the method taught collectively by Luchs and Felton with the motivation of allowing a customer to receive the most suitable quotation for insurance over the Internet (Cullen: col. 1 line 60 to col. 2 line 11).

Luchs, Felton, and Cullen does not expressly disclose the use of web pages.

Insuremarket discloses an insurance website for a customer to receive real-time quotes and purchase policies from the nation's leading insurance companies, wherein the customer enters information on a computer via a web browser over the Internet, wherein the Insuremarket system (reads on "insurance provider") receives information from multiple insurance companies

and displays the quotes to a user (reads on "notification"), wherein upon the customer receiving

the quotes, the customer is able to select the policy he or she would like and purchase the policy

(see pages 1-8). As per the recitation of "a later time period," the Examiner notes that the

Insuremarket discloses providing web pages over the Internet which would include an inherent

delay to load web pages on a client computer.

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the features of Insuremarket within the method taught collectively by Luchs,

Felton, and Cullen with the motivation of providing a quick way to access insurance information

using the Internet (pg. 2 of Insuremarket).

13.   Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

InsureMarket (Quicken website, Accessed from www.archive.org, dated 12/12/1998), Luchs et

al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes,"

The New York Times, March 23, 1997, pg. 3, 11) in view of 5,873,006 to Underwood et al.

(A) As per claim 21, Insuremarket discloses a method of providing insurance coverage

from an insurer to a customer in relation to a home insurance and auto insurance (pages 4 and 6)

comprising:

(a) receiving an inquiry at a server computer hosting a website of the insurer (pages 1-2,

6) (It is noted that a user is able to submit information, such as a zip code, through

Insuremarket's website to Insuremarket's server, which connects instantly to insurance

companies);

(b) providing an input for onto the internet to a first client computer operated by a

customer (pages 1, 4-8);

(c) receiving customer information at the server computer that has been input at the first

client computer by way of the input form (pages 1, 4-8);

(d) making a preliminary determination based upon the customer information as to

whether it is possible to provide the customer insurance of a first type with respect to the

customer-owned item (pages 6-7, It is noted that filling out a questionnaire of user requirements

for a policy, providing a summary screen that will let user's compare policy options from several

carriers, including the premiums, based on the questionnaire, and filling out an online application

is a form of "making a preliminary determination"); and

(e) providing an indication to be received by the customer concerning whether the

insurance of the first time can be provided with respect to the customer-owned item (pages 6-7,

see the purchase screen allowing the user to purchase the insurance policy).

Insuremarket fails to expressly disclose (e) providing a field for inputting a time

limitation relating to the insurance of the first type, the time limitation indicating a time period

less than a month; (f) receiving the time limitation at the server computer; (g) performing

processing in relation to the time limitation to determine whether the insurance of the first type

as restricted by the time limitation can be provided with respect to the customer-owned item; and

(h) providing an indication ... as restricted by the time limitation.

Luchs discloses:

(a) entering data into fields relating to a desired insurance coverage, wherein the fields

include the effective date of the insurance policy, the expiration date of the insurance policy, and

the zip code and state of the policy holder (Fig. 10A-B, col. 22 line 5 to col. 23 line 28), wherein

the insurance is related to a dwelling, a homeowner (i.e., a house), an automobile, and watercraft

(Fig. 10B, col. 7-8 see Table, col. 23 lines 3-15);

(b) receiving at the central processor, which includes a databank, the information entered

into fields (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);

(c) electronically and automatically comparing the data in the insurance application to

certain underwriting criteria before actually proceeding with the printing of the insurance

application, wherein the underwriting criteria compared with data include the effective date,

expiration date, and city/ country code (col. 4 lines 26-47, col. 7 line 28 to col. 11 line 2, col. 16

line 30 to col. 17 line 5);

(d) sending the policy to printing if the policy does not need further approval based on the

criteria, and wherein if further approval is needed, the policy is sent to underwriting for approval,

wherein the policy is limited to the effective date and expiration date (Fig. 10B, col. 16 lines 30-

52) (It is noted that "providing an indication" is taught by InsureMarket, but Insuremarket does

not clearly limit the policy based on a time limitation. This is taught by Luchs.)

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the features of Luchs within the method of InsureMarket with the motivation

of reducing the time and increasing the efficiency for a client to be underwritten and approved

for an insurance policy (Luchs; col. 1 lines 36-62).

Luchs includes the feature of receiving a customer specification setting time limits

regarding a desired amount of insurance coverage (i.e., the effective date and the expiration

date). However, InsureMarket and Luchs does not include the feature of the time limit

specifying a time period of less than a month. Felton discloses in his article that it is well known

in the insurance arts to provide insurance to customers, wherein the insurance is limited to

periods of time of 15 days or 30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to include the features of Felton within the method taught collectively by InsureMarket

and Luchs with the motivation of allowing a customer to reduce the high cost of insurance

(Felton; page 1).

InsureMarket, Luchs and Felton fail to teach the claimed (i) concluding an arrangement

so that the insurance is providing to the customer; and

--the claimed (j) repeating steps on at least one additional occasion so that the insurance

as restricted by at least one additional time limitation is provided to the customer.

Underwood et al. teaches a computer-implemented system for managing underwriting,

quoting and binding insurance companies, where at step 132, if a quote is accepted by the user a

policy is issued and accepted using a graphical user interface (see: column 6, lines 38-45 and Fig.

13). In addition, Underwood et al. teaches at step 106, entering policy limits such as the effective

and expiration dates (see: column 4, lines 32-35 and 7), this suggest that the policy could be

renewed and the all step repeated.

One of ordinary skill in the art at the time the invention was made would have found it

obvious to include the computer-implemented system for managing underwriting, quoting and

binding insurance companies as taught by Underwood et al. with the system as taught by

. InsureMarket, Luchs and Felton with the motivation of providing a system for quoting, binding

and later issuing an insurance contract in which all relevant information pertaining to the risk is

properly documented and permanently stored (see: Underwood et al.: column 1, lines 60-64).

Furthermore, InsureMarket, Luchs, Felton Underwood do not *expressly* disclose

repeating steps (e) through (i). However, it is noted that updating insurance information is well

known as described by Luchs client's that requests supplemental coverage or wants to add

further risks to a policy or rider (see: col. 1 lines 50-62). It is respectfully submitted that

repeating steps appears to be a form of duplication of "parts" (i.e., steps). The courts have

broadly held that the duplication of parts is obvious. *In re Harza*, 274 F.2d 669, 124 USPQ 378

(CCPA 1960). As such, these changes do not present a patentable distinction over the applied

prior art of record.

(B) As per claim 22, InsureMarket, Luchs, Felton and Underwood et al. teach at a time to

(i) receiving a request from the customer to adjust a geographic scope characteristic of the

insurance. This limitation is met by a client requesting supplemental coverage or wanting to add

further risks (i.e. adjusting geographic scope characteristic) to a policy or rider (see: Luchs: col. 1

lines 50-62). In addition, InsureMarket, Luchs, Felton and Underwood et al. in Fig. 10, there is a

heading for Auto Territory suggesting a geographic scope characteristic (see: Underwood et al.

Fig. 10).

(C) As per claim 23, Luchs discloses customer information including an identification

number corresponding to a customer-owned vehicle with respect to which the customer desires

to obtain insurance coverage (Fig. 11D, col. 25 lines 14-50). As per the recitation of "short-term

insurance coverage," see the discussion of Felton in claim 21. As per the recitation of a web page

in steps (b) and (h), note the discussion in claim 21 of web pages. As per the recitation of a web

page in step (e), Insuremarket discloses filling out an online application including limitations

pertaining to the policy (pages 6-7, #4). As per the recitation of "time limitations," note the discussion of Luchs and Felton in claim 21.

(D) As per claim 24, Insuremarket discloses determining the cost of insurance of the first type as restricted by limitations (i.e., zip code (reads on "geographic limitation") and other limitations – see page 6, par. 4) (see also pages 6-7, premium payments). As per the recitation of a time limitation, see the discussion in claim 21 of Luchs and Felton.

As per the recitation of "selectable menu items," it is respectfully submitted that "selectable menu items" are well known in the computer programming arts. Selectable menu items, such as drop down menus, are commonly used in web pages. The motivation for modifying Insuremarket, Luchs, and Felton being to provide a user-friendly interface for a customer and to prevent the user from having to enter information.

13.   Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over InsureMarket (Quicken website, Accessed from www.archive.org, dated 12/12/1998), Luchs et al. (4,831,526), and Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11) as applied to claim 21, and further in view of Hartigan (US 2002/0022976).

(E) As per claim 25, Insuremarket discloses saving, accessing, reviewing, and updating insurance information by a customer at any time through a personal insurance portfolio. It is noted that updating insurance information and purchasing insurance through Insuremarket (pages 6-7) is a form of repeatedly ordering amounts of insurance. Insuremarket, Luchs, and Felton do not expressly disclose establishing an identifier by which the customer is able to log in to the website repeatedly at future time periods using the client computer, the identifier including at

least one of a username and a password. Hartigan discloses entering policy information for a

new insured and generating an access code and password for that insured, wherein the insured is

able to enter information on insurance when logging in to the system (par. 12-13, par. 218-224,

claim 1).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to combine the teachings of Hartigan within the system taught collectively by

Insuremarket, Luchs, and Felton with the motivation of allowing a user to determine whether

they are eligible for insurance coverage (Hartigan; par. 10).

Response to Arguments

14.   Applicant's arguments filed 8/17/07 have been fully considered but they are not

persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they

appear in the response filed 8/17/07.

(A) In the remarks the Applicant argues in substance that, (1) the cited reference fail to

suggest the desirability of allowing a consumer to purchase short term insurance for his or her

own vehicle in order to "reduce the high cost of insurance"; and (2) The Examiner fails to set

forth a *prima facie* case of obviousness therefore, there is no motivation to combine reference

and it constitute an assertion of hindsight.

(B) In response to Applicant's argument that, (1) the cited reference fail to suggest the

desirability of allowing a consumer to purchase short term insurance for his or her own vehicle in

order to "reduce the high cost of insurance". The Examiner respectfully submit that the Luchs

reference is relied on for teaching that a client can request supplemental coverage or add further

risks to a policy or rider (see: col. 1 lines 50-62). In addition, Underwood et al is relied on

teaching a computer-implemented system for managing underwriting, quoting and binding

insurance companies, where at step 132, if a quote is accepted by the user a policy is issued and

accepted using a graphical user interface (see: column 6, lines 38-45 and Fig. 13). In addition,

Underwood et al. teaches at step 106, entering policy limits such as the effective and expiration

dates (see: column 4, lines 32-35 and 7), this suggest that the policy can be renewed and updated.

Moreover, it is noted that the features upon which applicant relies (i.e., "allowing a consumer to

purchase short term insurance") are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) In response to Applicant's argument that, (2) The Examiner fails to set forth a *prima*

facie case of obviousness therefore, there is no motivation to combine reference and it constitute

an assertion of hindsight. The Examiner respectfully submits that establishing a *prima facie* case

of obviousness is determined on the basis of the evidence as a whole and the relative

persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443,

1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992);

In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*,

531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner

respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of

obviousness, since he has presented evidence of corresponding claim elements in the prior art

and has expressly articulated the combinations and the motivations for combinations that fairly

suggest Appellant's claimed invention (paper dated 1/3/07).

In addition, the Examiner recognizes obviousness is not determined by what the

references expressly state but by what they would reasonably suggest to one of ordinary skill in

the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell,*

Terry and Davies 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598

(Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

> (i) obviousness does not require absolute predictability;
> (ii) non-preferred embodiments of prior art must also be considered; and
> (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner respectfully recognizes that references cannot be arbitrarily

altered or modified and that there must be some reason why one skilled in the art would be

motivated to make the proposed modifications. However, although the Examiner agrees that the

motivation or suggestion to make modifications must be articulated, it is respectfully contended

that there is no requirement that the motivation to make modifications must be expressly

articulated within the references themselves. References are evaluated by what they suggest to

one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545

(CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound

scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a

holding of obviousness has been adequately provided by the motivations and reasons indicated

by the Examiner in the prior Office Action (paper dated 1/7/07), *Ex parte Levengood*, 28

USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

With regard to the Appellant's argument that the combination of reference is improper

because the Examiner reconstructs the claimed invention based on impermissible hindsight, it

must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction

based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
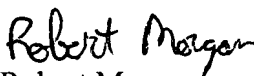
In response to Applicant other argument, it is respectfully submitted that the Examiner has applied new passages and citations to amended claims 1, 13, 14, 21 and 22 at the present time. The Examiner notes that amended limitations were not in the previously pending claims as such, Applicant's remarks with regard to the application of all applied references to the amended limitations are addressed in the above Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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